

REMARKS

Claims 1-34 were filed in the present case. Claims 7 and 25 were cancelled in a previous response. As such, Claims 1-6, 8-24, and 26-34 are currently pending. The Examiner has stated that the corrected formal drawings fail to comply with the Draftsperson's patent drawing review dated March 31, 2003 (Office Action, pg. 2). Applicants herewith submit the required drawing corrections in the form of substitute drawings.

Applicants note that all amendments of Claims presented herein are made without acquiescing to any of the Examiner's arguments or rejections, and solely for the purpose of expediting the patent application process in a manner consistent with the PTO's Patent Business Goals (PBG),¹ and without waiving the right to prosecute the amended Claims (or similar Claims) in the future.

In the present Office Action, the Examiner made a number of arguments, objections, and rejections. For clarity, the rejections at issue are set forth by number in the order they are herein addressed:

(1) Claims 1, 10, 23 and 28 stand rejected under 35 U.S.C. 112, second paragraph as allegedly being indefinite; and

(2) Claims 28, 31, and 134 stand rejected under 35 U.S.C. § 102 (b) as allegedly being anticipated by Chong et al. (Rapid Commun. Mass Spectrometr 12:1986 [1998]); hereinafter Chong).

I. The Claims are Definite

Claims 1, 10, 23 and 28 stand rejected under 35 U.S.C. 112, second paragraph as allegedly being indefinite (Office Action, pg. 3). In particular, the Examiner states "Claims 1, 10, 23, 28 , and all claims dependent therefrom are indefinite due to the lack of clarity of the claim language failing to recite a final process step, which agrees back with the preamble."

¹ 65 Fed. Reg. 54603 (Sept. 8, 2000).

(Office Action, pg. 3). The Applicants respectfully disagree. However, in order to further the business interests of the Applicants and while reserving the right to prosecute the original (or similar) claims in the future, the Applicants have amended Claims 1, 23, and 28 to include a preamble to which the final process step relates back. Thus, the Applicants submit that the claims are definite and request that the rejection be withdrawn.

The Examiner further states "claim 10 provides for the additional step of "determining the identity of individual bands on said protein profile map" which is confusing as to the goal/intent of the method of claim 1...." Office Action, pg. 3. The applicants respectfully disagree with this rejection. The amended Claim 1 is directed towards a method "of producing protein profile maps..." Claim 10 clearly describes an additional method step of "determining the identity of individual bands on **said protein profile map**," which clearly relates back to the preamble of Claim 1. As such, the Applicants respectfully request that the rejection be withdrawn.

II. The Claims are novel

Claims 28, 31 and 34 stand rejected under 35 U.S.C. § 102 (b) as allegedly being anticipated by Chong (Office Action, pg. 3). The Applicants respectfully disagree. The Applicants respectfully submit that Chong does not anticipate Claim 28 (and dependent Claims 31 and 34) because Chong does not teach all of the elements of Claim 28. However, in order to further the business interests of the Applicants and while reserving the right to prosecute the original (or similar) claims in the future, the Applicants have amended Claim 28 to require that the protein profile maps display each protein as a separate band corresponding to the mass of the protein samples, wherein the intensity of the bands corresponds to the abundance of the protein. The Examiner has pointed to no teaching in Chong that describes this claim element. As Chong does not teach this element of the claims, the Applicants respectfully submit that Chong does not anticipate Claims 28, 31 and 34. As such, the Applicants respectfully request that the rejection be withdrawn.

CONCLUSION

All grounds of rejection and objection of the Office Action of April 8, 2003 having been addressed, reconsideration of the application is respectfully requested. It is respectfully

submitted that the Claims should be allowed. Should the Examiner have any questions, or if a telephone conference would aid in the prosecution of the present application, Applicant encourages the Examiner to call the undersigned collect at 608-218-6900.

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